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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/817,251	03/27/2001	Hisao Hiramatsu	Q63803	8044

7590

11/06/2002

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EXAMINER

SOOHOO, TONY GLEN

ART UNIT	PAPER NUMBER
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1723

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DATE MAILED: 11/06/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/817,251

Applicant(s)

HIRAMATSU ET AL.

Examiner

Tony G Soohoo

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-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 August 2002.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-5, 7-8, and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Hargen 2432073.

Hargen teaches an apparatus and method for use in combination with a pan container (not shown) having opening at the top for access to the baster, and a liquid within the container.

Typically, it is known knowledge in basting methods to apply a meat product with juices including blood components from the pan container onto the food, see also, column 1, lines 1-12.

With regards to the method claims, the use of the device and its corresponding method requires the user to perform a dipping of the tube 2 into the pan at a given horizontal location between the meat and the container walls in order to access the basting liquid. Suction is applied via the piston 7 to pick up the liquid and some air in

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the chamber. Then, dispensing of the liquid is applied at a new horizontal position. This position is different from the suction position at which the liquid was taken from the pan, the dispensing of the liquid is typically above a meat product. The liquid is then delivered back into the pan at a different horizontal position than that of the sucking position since it drops off the sides meat. It is also noted that it is common knowledge in the art of cooking, in particular to the practice of basting, to provide multiple suction of liquid and dispensed applications of more than "n" times whereby "n" is an integer of 2 or more whereby if "n" is increased, the meat may be less dry. Additionally, it is noted that since the device is manipulated by hand, the sucking and discharge position at a n location, would differ from that of the previous location (n-1) of the respective sucking and dispensing positions since indexing of the position is done by, and limited by, human physical factors, may not readily provide a duplication of the placement of the suction/dispensing position such that it is duplicate in position.

Thus, it is noted that the recited manipulative steps would satisfy the claimed method steps and that furthermore, the subsequent physical manipulate steps of suction of liquid and dispensed application of liquid falling back into the pan would thereby cause an outcome of a manipulative end effect of upon the liquid within the pan such that the liquid may be considered to be "stirred".

With regards to the apparatus claims, there is a means for sucking and discharging 2 the liquid, and a handle means 6 capable of horizontally moving the pipette (via the user's hand) so that it physically be capable of horizontally moving so that the liquid is discharged into the container at a position from that where the liquid

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has been sucked from the container. With regards to the apparatus claims, it is noted it has been held that the recitation that an element is capable to perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138. In this case the handle means or the user's hand provides the ability to perform the recited means plus function.

With regards to claim 8, the clause "wherein the means horizontally moves so that the liquid is discharged..." has not been given patentable weight to the claimed scope of the structure presented to the claims whereby the clause is an intended use of the "means for sucking". It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).

4. Claims 8 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Raczak 3656351.

Raczak teaches an apparatus for use in combination with a container (not shown) having opening at the top for access to the pipette, and a liquid within the container, whereby additionally there is a means for sucking and discharging the liquid 15, 58, and a handle means capable of horizontally moving the pipette (via the user's hand) so that it physically be capable of horizontally moving so that the liquid is

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discharged into the container at a position from that where the liquid has been sucked from the container.

With regards to claim 8, the clause "wherein the means horizontally moves so that the liquid is discharged..." has not been given patentable weight to the claimed scope of the structure presented to the claims whereby the clause is an intended use of the "means for sucking". It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

5. Claims 1-3 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Lehman 3320053

Lehman teaches an apparatus and method for use in combination with an open top container 6 having an inclination on the sidewall of the container, which the inclination increases in height toward the outside of the container (figure 1), and a liquid in the container.

With regards to the method claims, the use of the device and its corresponding method performs the steps of sucking liquid from an elongate nozzle section 3 with an opening 2 into the nozzle chamber 3 and discharging it to a horizontally different position left side of the nozzle section 3 via the opening 5. Note that the liquid is discharged toward the inclination of the sides of the container 6 since the opening 5 of the nozzle 3 is oriented in an outward direction towards the container inclined wall. It is

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noted that whereas the claims are "inclusive" of other elements in claim construction via the use of "comprising". Thus when Lehman's element 3 is defined as the nozzle element with two openings, the method of operation of the device fully anticipates the method steps of pickup and discharge of the liquid into and out of a single nozzle 3.

Additionally, it is noted that since the method provides multiple successive suction and discharge of the liquid thus would inherently mix the liquid as a secondary effect to the process defined by Lehman.

Thus, it is noted that the recited manipulative steps would satisfy the claimed method steps and that furthermore, the subsequent physical manipulate steps of suction of liquid and dispensed application of liquid would thereby cause an outcome of a manipulative end effect of upon the liquid such that the liquid may be considered to be "stirred".

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 6, 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hargen 2432073.

Hargen 2432073 discloses all of the recited subject matter as defined within the scope of the claims with the exception of the container being used has the feature that

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the inside wall is inclined in a direction increasing in height toward the outside of the container.

It is old and well known in the art of containers and common knowledge to a person having ordinary skill in the art, and in particular within the art of pans, to provide inclined walls inclined in a direction increasing in height toward the outside of the container. It is commonly known that this provides a greater volume for a given base footprint, and may provide a greater opening area for easier access into the container and the container bottom.

Accordingly, it is deemed that it would have been obvious to one of ordinary skill in the art to provide for the container used in Hargen's method, or substitute the container used in Hargen with a container having inclined walls inclined in a direction increasing in height toward the outside of the container so that it provides a greater volume for a given base footprint, and may provide a greater opening area for easier access into the container and the container bottom so that one may access the liquid surface in a more easier manner so that basting may be performed in a more effective operation.

8. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Raczak 3656351.

Raczak 2432073 discloses all of the recited subject matter as defined within the scope of the claims with the exception of the container being used has the feature that

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the inside wall is inclined in a direction increasing in height toward the outside of the container.

It is old and well known in the art of containers and common knowledge to a person having ordinary skill in the art, and in particular within the art of laboratory equipment containers, to provide inclined walls inclined in a direction increasing in height toward the outside of the container. It is commonly known that this provides a greater volume for a given base footprint, and may provide a greater opening area for easier access into the container and the container bottom.

Accordingly, it is deemed that it would have been obvious to one of ordinary skill in the art to provide for the container used in Raczak's method, or substitute the container used in Raczak with a container having inclined walls inclined in a direction increasing in height toward the outside of the container so that it provides a greater volume for a given base footprint, and may provide a greater opening area for easier access into the container and the container bottom so that one may access the liquid surface with the pipette nozzle in a more easier manner so that removal or dispensing of the liquid within the pipette may be performed in a more effective operation.

Response to Arguments

9. Applicant's arguments filed 8/15/02 have been fully considered but they are not persuasive. Applicant argues that the Hargen reference does not anticipate the claims whereby "Hargen discloses ... that liquid is expelled in a spray or stream over the cooking food, causing the food to be basted... the liquid is expelled over the cooking food in order to bast[e] the food, and therefore stirring does not occur in the liquid". In

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response, the Examiner has shown that in common usage of the manipulation of basting the food, some liquid is then delivered back into the pan at a different horizontal position than that of the sucking position since it drops off the sides meat hence mixing of liquid occurs.

It is further noted that the construction of the claim is inclusive of other steps via the use of "comprising". The claims are so broad in scope that the method of roasting a meat and basting the meat, reads, prima fascia to the claim limitations. It is further noted that any liquid is absorbed by the meat upon basting, the liquid may return back out from the meat as further juices are expelled from the meat during cooking. Once the further some juices are expelled from the meat is of an amount to fall into the pan, the juice, (i.e. water and cooked blood components) liquid is returned back into the pan which mixes back into the juices into the pan.

Accordingly, applicant's arguments with regards to Hagen is not persuasive. Applicant argues that "In particular, Raczak neither discloses or suggest sucking and discharging in the same container". In response, claims 8 and 10 are apparatus claims requiring a means for sucking, for example a nozzle with a suction provider. The claims at issue are not method claims, a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).

Raczak shows a means a "means for sucking" i.e, a nozzle opening with vacuum piston, therefore it is deemed to fully satisfy, prima fascia, a "means for sucking" or

equivalents thereof. Applicant's attempt in the use of the means plus function clause state "means for sucking a part of the liquid from the container and for discharging the sucked liquid into the liquid remaining in the container." The phrase "a part of the liquid from the container and for discharging the sucked liquid into the liquid remaining in the container" is deemed as intended use of the structure of "means for sucking" Although Raczak may fully structurally function to sucking a part of the liquid from the container and for discharging the sucked liquid into the liquid remaining in the container, issues that Raczak does not teach this is immaterial to the anticipation of the structure shown by Raczak. In order to rebut Raczak with regards to claims 8 and 10, applicant must show that Raczak can not structurally operate to rails and discharge liquid from the same container.

Applicant argues that Lehman does not anticipate the claimed method whereby applicant asserts that Lehman uses two nozzles, a right nozzle 2 and left nozzle 5 for pickup and discharge, while applicant uses a the same nozzle. Applicant attempted to overcome such a feature by adding the new element of adding the use of "into a nozzle" and "form the nozzle" in the amended language of the method claim 1 of 8/15/02.

In response, Lehman shows a method of perform of the steps of sucking liquid from into a nozzle section 3 via open 2 into the nozzle chamber 3 and discharging it to a horizontally different position left side of the nozzle section 3 via the opening 5. In this interpretation, the Lehman reference still reads upon the claimed invention as amended.. Also, whereas the claims are "inclusive" of other elements in claim construction via the use of "comprising" and since no language to distinguish or limit the particular type of nozzle structure, a use of a nozzle with multiple openings is within the scope of the claims in question. Thus, when Lehman's element 3 is defined as the

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single nozzle element with two openings, the method of operation of nozzle element 3 of the device fully anticipates applicant's method steps of pickup and discharge of the liquid into and out of a single nozzle 3.

Conclusion

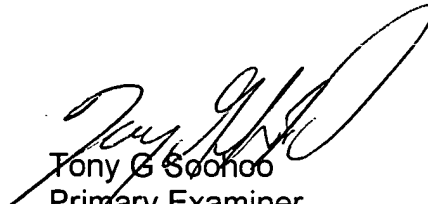
10. Applicant's amendment of the inclusion of a use of a nozzle element in the method of claim 1 has necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following patents show further examples nozzle devices and methods with pick up liquid for discharge: Barthold 5297980, Cloud, Jr 1031526 and Chestney 4077629.

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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tony G Soohoo whose telephone number is (703) 308-2882. The examiner can normally be reached on 7:00 AM - 5:00 PM, Tues. - Fri.. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Tony G Soohoo
Primary Examiner
Art Unit 1723

tgs